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EXAMINER

MILIA, MARK R

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 11/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/916,370

Applicant(s)

LOPEZ ET AL.

Examiner

Mark R. Milia

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26,28-33 and 35-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26,28-33 and 35-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 August 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8-22-05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's amendment was received on 8/22/05 and has been entered and made of record. Currently, claims 1-26, 28-33, and 35-37 are pending.

Drawings

2. Applicant's amendments to Figures 1A, 1B, and 7 have overcome the objection to the Drawings as cited in the previous Office Action. Therefore the objections have been withdrawn.

Specification

3. Applicant's amendment to the specification to delete an unnecessary hyperlink has overcome the objection to the specification as cited in the previous Office Action. Therefore the objection has been withdrawn.

Claim Rejections - 35 USC § 112

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4. Applicant's amendment to claim 23 to add the limitation "and for obtaining certain of the image files that satisfy filter criteria indicative of at least one image file characteristic" has overcome the rejection to claim 28 for lacking antecedent basis for the phrase "the filter criteria", as cited in the previous Office Action. Therefore the rejection has been withdrawn.

Claim Objections

5. Claims 12 and 16-19 were objected to in the previous Office Action as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The objection has been withdrawn due to newly found prior art and a different interpretation of the claim language.

6. Claim 28 was objected to in the previous Office Action as being allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph and to include all of the limitations of the base claim and any intervening claims. The objection has been withdrawn due to newly found prior art and a different interpretation of the claim language.

Response to Arguments

7. Applicant's arguments, see pages 12-21, filed 8/22/05, with respect to the rejection(s) of claim(s) 1-11, 13-15, and 20-35 under 35 U.S.C. 102(e) and 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. Particularly, the examiner agrees that the reference of Yamaguchi fails to disclose "predetermined criteria indicative of at least one file characteristic so as to identify certain ones of the image files as qualified image files" as now recited in claims 1, 23, and 29. Further, regarding the amendments to claims 20, 30, and 31, the examiner agrees that the references of Yamaguchi and Kato fail to disclose "determining from the at least one identity marker the web location for those ones of the image files associated with the marked selection areas". However, upon further consideration, a new ground(s) of rejection is made in view of newly found prior art and the current amendments to the claims. Newly added claims 36 and 37 will be addressed in the following rejection.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-9, 16-19, 29, 36, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication No. 2003/0123079 to Yamaguchi et al. in view of U.S. Patent No. 6122657 to Hoffman Jr. et al.

Regarding claims 1 and 29, Yamaguchi discloses a method and system of printing with a printing system, comprising: analyzing a web page with the printing system to identify image files associated with the web page (see paragraphs [0084]-[0087]), filtering the image files with the printing system according to predetermined criteria so as to identify qualified image files (see Figs. 5-9, Table 1, and paragraphs [0113], and [0116]-[0189], reference shows a plurality of options available to a user that filter image content and output which is analogous to the claim limitation), selecting at least one of the qualified image files (see paragraphs [0095]-[0098] and [0104]), and printing the selected ones of the qualified image files (see paragraphs [0104]-[0105]).

Yamaguchi does not disclose expressly filtering the image files with the printing system according to predetermined criteria indicative of at least one file characteristic so as to identify certain ones of the image files as qualified image files.

Hoffman discloses filtering the image files with the printing system according to predetermined criteria indicative of at least one file characteristic so as to identify certain ones of the image files as qualified image files (see column 5 lines 13-20, column 6 lines 33-48, column 8 lines 20-32 and 39-52, column 25 lines 58-67, and column 30 lines 23-28).

Regarding claim 16, Yamaguchi discloses a method of printing with a printing system, comprising: analyzing a web page with the printing system to identify image

files associated with the web page (see paragraphs [0084]-[0087]), filtering the image files with the printing system according to predetermined criteria so as to identify qualified image files (see Figs. 5-9, Table 1, and paragraphs [0113], and [0116]-[0189], reference shows a plurality of options available to a user that filter image content and output which is analogous to the claim limitation), selecting at least one of the qualified image files (see paragraphs [0095]-[0098] and [0104]), and printing the selected ones of the qualified image files (see paragraphs [0104]-[0105]).

Yamaguchi does not disclose expressly determining at least one file characteristic associated with each of the image files, for each of the image files, comparing the at least one file characteristic to the predetermined criteria, and denoting ones of the image files for which the at least one file characteristic matches the predetermined criteria as the qualified image files.

Hoffman discloses filtering the image files with the printing system according to predetermined criteria so as to identify qualified image files (see column 5 lines 13-20, column 6 lines 33-48, column 8 lines 20-32 and 39-52, column 25 lines 58-67, and column 30 lines 23-28), determining at least one file characteristic associated with each of the image files (see column 5 lines 13-20, column 28 lines 49-57, and column 30 lines 23-28), for each of the image files, comparing the at least one file characteristic to the predetermined criteria (see column 28 lines 49-57 and column 30 lines 23-28), and denoting ones of the image files for which the at least one file characteristic matches the predetermined criteria as the qualified image files (see column 8 lines 20-53 and column 30 lines 23-28, reference shows that when the filter criteria is set so that a image larger

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than a predetermined size is detected that the image is "killed" and not allowed to be passed to the system and if the image is of a proper size then the image is passed through, which shows a matching to the filter criteria).

Yamaguchi & Hoffman are combinable because they are from the same field of endeavor, retrieving HTML data for eventual execution and output.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the filtering of data as described by Hoffman with the system of Yamaguchi.

The suggestion/motivation for doing so would have been to increase system speed by eliminating unnecessary or unwanted data from being retrieved (see column 2 lines 45-67 of Hoffman).

Therefore, it would have been obvious to combine Hoffman with Yamaguchi to obtain the invention as specified in claims 1, 16, and 29.

Regarding claim 2, Yamaguchi and Hoffman disclose the system discussed in claim 1, and Yamaguchi further discloses electronically acquiring the web page with the printing system (see paragraphs [0084]-[0087] and [0100]).

Regarding claim 3, Yamaguchi and Hoffman disclose the system discussed in claim 1, and Yamaguchi further discloses electronically obtaining the selected ones of the qualified image files (see paragraphs [0084]-[0087], [0095]-[0098], [0100]-[0105], [0113], and [0116]-[0189]).

Regarding claim 4, Yamaguchi and Hoffman disclose the system discussed in claim 2, and Yamaguchi further discloses providing a web page identifier (see paragraph [0102]) and downloading to the printing system a web page source file that corresponds to the web page identifier (see paragraphs [0111]-[0113]).

Regarding claim 5, Yamaguchi and Hoffman disclose the system discussed in claim 4, and Yamaguchi further discloses performing a dialog according to http protocol to obtain the web page source file (see paragraphs [0111]-[0112]).

Regarding claim 6, Yamaguchi and Hoffman disclose the system discussed in claim 4, and Yamaguchi further discloses wherein the web page identifier is a URL (see paragraph [0102]).

Regarding claim 7, Yamaguchi and Hoffman disclose the system discussed in claim 4, and Yamaguchi further discloses wherein the web page identifier is prestored in the printing system (see Fig. 10 and paragraph [0244]).

Regarding claim 8, Yamaguchi and Hoffman disclose the system discussed in claim 4, and Yamaguchi further discloses wherein the web page source file contains markup text, and wherein the analyzing further comprises parsing the markup text to identify the image files associated with the web page (see paragraphs [0111]-[0112]).

Regarding claim 9, Yamaguchi and Hoffman disclose the system discussed in claim 8, and Yamaguchi further discloses parsing the markup text to identify image file pathnames embedded therein (see paragraphs [0112], [0119]-[0120], [0127]-[0128], and [0154]-[0155]), determining which ones of the image files are located at the corresponding image file pathnames (see paragraphs [0119]-[0120], [0127]-[0128], and

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[0154]-[0155]), and determining which other ones of the image files are located at other pathnames associated with the corresponding image tile pathnames (see paragraphs [0119]-[0120], [0127]-[0128], and [0154]-[0155]).

Regarding claim 17, Yamaguchi and Hoffman disclose the system discussed in claim 16, and Hoffman further discloses wherein each file characteristic is selected from the group consisting of a file type of the image file, a file size of the image file, an rendered image size of the image file, an image property of the image file, textual information associated with the image file, and a file name of the image file (see column 30 lines 23-28, reference shows a filter criteria based on image size).

Regarding claims 18 and 36, Yamaguchi and Hoffman disclose the system discussed in claims 1 and 16, and Hoffman further discloses identifying at least some of the file characteristics from contents of the web page (see column 8 lines 20-32 and 39-53, column 25 lines 58-67, and column 28 lines 49-57, reference shows that an HTML tag is detected and utilized to acquire qualified filter criteria).

Regarding claim 19 and 37, Yamaguchi and Hoffman disclose the system discussed in claims 1 and 16, and Hoffman further discloses identifying at least some of the file characteristics from contents of the image file (see column 30 lines 23-28, reference shows the filter criteria based on the size of the image file).

10. Claims 20-22, 30, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6141111 to Kato as cited on Information Disclosure

Statement dated July 27, 2001 in view of Yamaguchi and U.S. Patent No. 6942150 to Knowles.

Regarding claims 20 and 30, Kato discloses a method and system of printing with a multifunction printing system, comprising: printing a proof sheet for at least some of the image files, the proof sheet having an image identifier and at least one corresponding selection area for each of the at least some of the image file (see Fig. 4 and column 5 line 25-column 6 line 5), marking at least one of the selection areas corresponding to at least one of the image files to be printed (see Fig. 4 and column 5 lines 35-47), optically scanning the marked proof sheet so as to determine marked selection areas (see Fig. 1 and column 6 lines 21-25, reference states that the operator enters the desired information onto the designation sheet and then inputs the sheet into the image printer, this is done by use of the attached scanner, further support for this can be found in claims 1, 3, and 11, therefore the reference disclose the claimed limitation), and printing the image files associated with the marked selection areas (see Fig 5 (S9) and column 6 lines 39-44).

Kato does not disclose expressly automatically analyzing a web page to identify image files associated with the web page, at least one identity marker indicative of a web location for each of the at least some of the image files, and determining from the at least one identity marker the web location for those ones of the image files associated with the marked selection areas.

Yamaguchi discloses automatically analyzing a web page to identify image files associated with the web page (see paragraphs [0084]-[0087]).

Knowles discloses at least one identity marker indicative of a web location for each of the at least some of the image files and determining from the at least one identity marker the web location for those ones of the image files associated with the marked selection areas (see abstract, Fig. 1A, column 2 lines 28-35, column 5 lines 21-37 and 60-66, column 6 lines 4-7 and 16-26, and column 9 lines 12-27, reference shows that a bar code indicative of a web location can be printed and used to communicate a web location to a computing system and when the bar code is scanned by a scanner the web page to which the bar code is associated with is thus connected to).

Regarding claim 31, Kato discloses a multifunction printing system, comprising: means for forming a user-markable proof sheet having an indicia of each of the certain image files and a user-designation area associated with each indicia (see Figs. 4 and 8 and column 5 line 25-column 6 line 5), means for identifying the user-designated ones of the certain image files from the marked proof sheet (see column 6 lines 11-52), means for obtaining the user-designated ones of the certain image files (see Figs. 4 and 8 and column 6 lines 39-44), and means for printing the user-designated ones of the image files (see column 6 lines 39-44).

Kato does not disclose expressly means for identifying and obtaining certain image files associated with a web page, at least one identity marker indicative of a web location for each of the at least some of the image files, and determining from the at least one identity marker the web location for those ones of the image files associated with the marked selection areas.

Yamaguchi discloses means for identifying and obtaining certain image files associated with a web page (see paragraphs [0084]-[0087], [0095]-[0098], [0100], and [0102]-[0105]).

Knowles discloses at least one identity marker indicative of a web location for each of the at least some of the image files and determining from the at least one identity marker the web location for those ones of the image files associated with the marked selection areas (see abstract, Fig. 1A, column 2 lines 28-35, column 5 lines 21-37 and 60-66, column 6 lines 4-7 and 16-26, and column 9 lines 12-27, reference shows that a bar code indicative of a web location can be printed and used to communicate a web location to a computing system and when the bar code is scanned by a scanner the web page to which the bar code is associated with is thus connected to).

Kato, Yamaguchi, & Knowles are combinable because they are from the same field of endeavor, retrieval of data via a network.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the web page analyzer to identify images to be output by a printer as described by Yamaguchi and identity marker indicative of a web location as described by Knowles with the system of Kato.

The suggestion/motivation for doing so would have been to provide greater access to image files, without the need for manual input, that may be located on a remote network, such as the Internet.

Therefore, it would have been obvious to combine Yamaguchi and Knowles with Kato to obtain the invention as specified in claims 20, 30, and 31.

Regarding claim 21, Kato, Yamaguchi, and Knowles disclose the system discussed in claim 20, and Yamaguchi further discloses automatically filtering the image files according to predetermined criteria so as to determine the image files (see Figs. 5-9, Table 1, and paragraphs [0113], and [0116]-[0189], reference shows a plurality of options available to a user that filter image content, such as only printing the web page when it has been updated, which is analogous to the claim limitation).

Regarding claim 22, Kato and Yamaguchi disclose the system discussed in claim 20, and Kato further discloses wherein each selection area includes a plurality of size fields, each size field for specifying a different one of a print size for the corresponding image file (see Fig. 8 and column 8 lines 8-21), wherein the marking includes marking at least one of the size fields (see Fig. 8 and column 8 lines 8-21 and 32-38), wherein the scanning includes determining the marked size fields (see column 8 lines 36-46), and wherein the printing the image files further includes printing each selected image file in the print size indicated by the corresponding marked size field (see column 8 lines 39-55).

11. Claims 23-26, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kato in view of Hoffman.

Regarding claim 23, Kato discloses a multifunction printing system comprising: an image proofing subsystem coupled to the web page analysis subsystem for forming a user-markable proof sheet having an indicia of each of the certain image files and a

user-designation area associated with each indicia (see Figs. 4 and 8 and column 5 line 25-column 6 line 5), a proof sheet analyzer subsystem adapted to identify the user-designated ones of the certain image files from the marked proof sheet and obtain the user-designated ones of the certain image files (see Figs. 1 and 2 and column 5 line 25-column 6 line 52), and an image printing subsystem coupled to the proof sheet analyzer subsystem for printing the user-designated ones of the image files (see Fig. 1 and column 6 lines 11-52).

Kato does not disclose expressly a web page analyzer subsystem for identifying and obtaining certain image files associated with a specified web page and for obtaining certain of the image files that satisfy filter criteria indicative of at least one image file characteristic.

Hoffman discloses a web page analyzer subsystem for identifying image files associated with a specified web page (see column 5 lines 13-20, column 6 lines 32-47, and column 26 lines 63-67), obtaining certain of the image files that satisfy filter criteria indicative of at least one image file characteristic (see column 5 lines 13-20, column 6 lines 33-48, column 8 lines 20-32 and 39-52, column 25 lines 58-67, and column 30 lines 23-28).

Kato & Hoffman are combinable because they are from the same field of endeavor, retrieving data for eventual execution and output.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the web page analyzer and filter criteria system as described by Hoffman with the system of Kato.

The suggestion/motivation for doing so would have been to increase system speed by eliminating unnecessary or unwanted data from being retrieved (see column 2 lines 45-67 of Hoffman).

Therefore, it would have been obvious to combine Hoffman with Kato to obtain the invention as specified in claim 23.

Regarding claim 24, Kato and Hoffman disclose the system discussed in claim 23, and Hoffman further discloses an internet access subsystem coupled to the web page analyzer subsystem and the proof sheet analyzer subsystem for obtaining the certain image files (see Figs. 1-3 and column 7 lines 50-56).

Regarding claim 25, Kato and Hoffman disclose the system discussed in claim 23, and Kato further discloses a printer subsystem coupled to the image proofing subsystem for printing the user-markable proof sheet and coupled to the image printing subsystem for printing the user-designated ones of the image files (see Fig. 1, column 5 line 50-column 6 line 5, and column 6 lines 11-52).

Regarding claim 26, Kato and Hoffman disclose the system discussed in claim 23, and Kato further discloses a scanner subsystem coupled to the proof sheet analyzer subsystem for optically scanning the marked proof sheet (see Fig. 1 and column 6 lines 21-25, reference states that the operator enters the desired information onto the designation sheet and then inputs the sheet into the image printer, this is done by use of the attached scanner, further support for this can be found in claims 1, 3, and 11, therefore the reference disclose the claimed limitation).

Regarding claim 28, Kato and Hoffman disclose the system discussed in claim 23, and Hoffman further discloses wherein the filter criteria are selected from the group consisting of a file type of the image tile, a file size of the image file, an image size of the image file, an image property of the image file, textual information associated with the image file, and a file name of the image file (see column 30 lines 23-28, reference , shows a filter criteria based on image size).

12. Claims 32 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6657702 to Chui et al. in view of Kato and Hoffman.

Chui discloses a method of printing with a printing system comprising analyzing a web page with the printing system to identify image files associated with the web page (see Fig. 5, column 10 lines 42-51, column 12 lines 39-51, column 13 line 66-column 14 line 8, and column 15 lines 36-47), a corresponding image specifier for each qualified one of the image files (see column 14 lines 15-22), providing at least one of the image specifiers to the printing system (see column 14 lines 15-22), and printing the image file associated with each of the provided image specifiers (see column 10 lines 59-65 and column 14 lines 49-52).

Chui does not disclose expressly filtering the identified image files with the printing system to determine the qualified ones of the image files, printing a proof sheet for qualified ones of the image files, the proof sheet having an image identifier and corresponding specifier for each qualified one of the image files.

Kato discloses printing a proof sheet for qualified ones of the image files, the proof sheet having an image identifier and corresponding specifier for each qualified one of the image files (see Fig. 4 and column 5 line 25-column 6 line 5).

Hoffman discloses filtering the identified image files with the printing system to determine the qualified ones of the image files (see column 5 lines 13-20, column 6 lines 33-48, column 8 lines 20-32 and 39-52, column 25 lines 58-67, and column 30 lines 23-28).

Chui, Kato, & Hoffman are combinable because they are from the same field of endeavor, retrieving data for eventual execution and output.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the proof sheet printing and processing as described by Kato and the filtering of image files as described by Hoffman with the system of Chui.

The suggestion/motivation for doing so would have been to provide a quick reference guide of images available for the user to print in hard copy form with associated image information.

Therefore, it would have been obvious to combine Kato and Hoffman with Chui to obtain the invention as specified in claim 32.

Regarding claim 33, Chui and Kato disclose the system discussed in claim 32, and Chui further discloses wherein each image specifier is an alphanumeric value, and wherein the providing includes entering the alphanumeric value into a user interface of the printing system (see column 14 lines 15-22).

13. Claims 10, 13-15, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamaguchi and Hoffman as applied to claim 1 above, and further in view of Kato.

Regarding claim 10, Yamaguchi and Hoffman do not disclose expressly printing a proof sheet for the qualified image files, the proof sheet having for each of the qualified image files an image indicia and a corresponding selection area, marking at least one of the selection areas corresponding to at least one of the qualified image tiles to be printed, optically scanning the marked proof sheet to form a scanned image, and processing the scanned image so as to determine the selected ones of the qualified image files.

Kato discloses printing a proof sheet for the qualified image files, the proof sheet having for each of the qualified image files an image indicia and a corresponding selection area (see Fig. 4 and column 5 line 25-column 6 line 5), marking at least one of the selection areas corresponding to at least one of the qualified image tiles to be printed (see Fig. 4 and column 5 lines 35-47), optically scanning the marked proof sheet to form a scanned image (see Fig. 1 and column 6 lines 21-25, reference states that the operator enters the desired information onto the designation sheet and then inputs the sheet into the image printer, this is done by use of the attached scanner, further support for this can be found in claims 1, 3, and 11, therefore the reference disclose the claimed limitation), and processing the scanned image so as to determine the selected ones of the qualified image files (see column 6 lines 26-44).

Regarding claim 13, Yamaguchi and Hoffman do not disclose expressly wherein the image indicia is a thumbnail image.

Kato discloses wherein the image indicia is a thumbnail image (see Fig. 4 and column 5 lines 39-41 and 50-61).

Regarding claim 14, Yamaguchi and Hoffman do not disclose expressly wherein the image indicia is a filename.

Kato discloses wherein the image indicia is a filename (see Fig. 4 (102), reference states that the compressed data becomes the **basis** of the image index portion (102) and as shown in figure 4 it can also be the filename, i.e. image A).

Regarding claim 15, Yamaguchi and Hoffman do not disclose expressly wherein the printing a proof sheet further comprises obtaining the qualified image files and processing each of the qualified image files to form the corresponding thumbnail image.

Kato discloses wherein the printing a proof sheet further comprises obtaining the qualified image files and processing each of the qualified image files to form the corresponding thumbnail image (see column 5 lines 50-61).

Regarding claim 35, Yamaguchi and Hoffman do not disclose expressly printing a proof sheet for the qualified image files, the proof sheet having for each of the qualified image tiles an image indicia and a corresponding image specifier, and providing at least one of the image specifiers to the printing system so as to determine the selected ones of the qualified image files.

Kato discloses printing a proof sheet for the qualified image files, the proof sheet having for each of the qualified image tiles an image indicia and a corresponding image

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specifier (see Fig. 4 and column 5 line 25-column 6 line 5) and providing at least one of the image specifiers to the printing system so as to determine the selected ones of the qualified image files (see column 5 lines 5-22 and column 6 lines 11-52).

Yamaguchi, Hoffman, & Kato are combinable because they are from the same field of endeavor, retrieving data for eventual execution and output.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the proof sheet printing a marking process as described by Kato with the system of Yamaguchi and Hoffman.

The suggestion/motivation for doing so would have been to provide an efficient way to acquire copies of prints with the desired properties using only a multifunction printer.

Therefore, it would have been obvious to combine Kato with Yamaguchi to obtain the invention as specified in claims 10, 13-15, and 35.

14. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kato, Yamaguchi, and Hoffman as applied to claim 10 above, and further in view of U.S. Patent No. 6784925 to Tomat et al.

Regarding claim 11, Kato, Yamaguchi, and Hoffman do not disclose expressly wherein the printing a proof sheet further includes printing at least one identity marker indicative of a web location for each of the image files.

Tomat discloses wherein the printing a proof sheet further includes printing at least one identity marker indicative of a web location for each of the image files (see Fig. 41 and column 13 lines 16-28).

Kato, Yamaguchi, Hoffman, & Tomat are combinable because they are from the same field of endeavor, retrieving data for eventual execution and output.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the identity marker as shown by Tomat with the system of Kato, Yamaguchi, and Hoffman.

The suggestion/motivation for doing so would have been to provide an image files location information to allow a plurality of users to locate a particular image file with ease.

Therefore, it would have been obvious to combine Tomat with Kato and Yamaguchi to obtain the invention as specified in claim 11.

15. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kato, Yamaguchi, Hoffman, and Tomat as applied to claim 11 above, and further in view of Knowles.

Kato, Yamaguchi, Hoffman, and Tomat do not disclose expressly determining from the at least one identity marker the web location for the selected ones of the qualified image files.

Knowles discloses determining from the at least one identity marker the web location for the selected ones of the qualified image files (see abstract, Fig. 1A, column

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2 lines 28-35, column 5 lines 21-37 and 60-66, column 6 lines 4-7 and 16-26, and column 9 lines 12-27, reference shows that a bar code indicative of a web location can be printed and used to communicate a web location to a computing system and when the bar code is scanned by a scanner the web page to which the bar code is associated with is thus connected to).

Kato, Yamaguchi, Hoffman, Tomat, & Knowles are combinable because they are from the same field of endeavor, retrieving data for eventual execution and output.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the identity marker indicative of a web location as described by Knowles with the system of Kato, Yamaguchi, Hoffman, and Tomat.

The suggestion/motivation for doing so would have been to provide greater access to image files, without the need for manual input, that may be located on a remote network, such as the Internet.

Therefore, it would have been obvious to combine Knowles with Kato, Yamaguchi, Hoffman, and Tomat to obtain the invention as specified in claim 12.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark R. Milia whose telephone number is (571) 272-7408. The examiner can normally be reached M-F 8:00am-4:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached at (571) 272-7402. The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

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Mark R. Milia
Examiner
Art Unit 2622

MRM

JOSEPH R. POKRZYWA
PRIMARY EXAMINER
ART UNIT 2622

